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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,410	02/14/2006	Domonique Teyssie	285619US0PCT	7551

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EXAMINER

ZEMEL, IRINA SOPHIA

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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03/11/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/568,410	Applicant(s) TEYSSIE ET AL.	
	Examiner Irina S. Zemel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,6-10 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12-07-2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Claims 11 and 13 are withdrawn from further consideration as being drawn to a nonelected invention, there being no allowable generic or linking claim. The restriction requirement set forth in the Office action dated 12-2-2008 is re-instated. The claims were restricted based on lack of novel technical feature, which reason applies to the claims as pending in the application now in view of the art submitted by the applicants. (See detailed discussion below). Since the examination in this case was limited to the elected group I (and the other invention Groups were re-joined with invention Group I based on the subject matter of Group I being allowable), the examination of previously elected invention Group I will continue in this RCE case.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites a possible choice of crosslinking agent groups as hydrosilyl groups, but the base claim I limits the crosslinking agents to isocyanates. Thus, it is not clear whether the recited crosslinking agents having

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hydrosilyl groups are additional agents or the claims fails to further limit the base claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 -3, 7-10, and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-189607 to Kanegafuchi '607.

Kanegafuchi '607 discloses a compositions suitable for molding processing, the composition comprises a crosslinked polymer having functional groups (A) and a second polymer (B). The polymer having functional groups is disclosed as polyisobutylene (abstract, illustrative examples, and the functional groups can be hydroxyl groups (claim 4). The reference further expressly discloses addition of crosslinking agent having functional groups reactive with functional groups of polymer (A). Crosslinking agent can have isocyanate groups [0034]. The second polymer (B) is defined as either having acrylic or styrene monomer units. [0030].]. Intended use of the composition for roofing or building materials is inherently met by the disclosure of the reference as disclosing substantially identical compositions to those disclosed and claimed in the instant specification.

The invention as claimed, therefore, is fully anticipated by the disclosure of the Kanegafushi '607 reference.

Claims 1-3, 7-10, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2002-105341 to Kanegafuchi Chemical Ind., (hereinafter Kanegafuchi '341").

Kanegafuchi '314 discloses a composition suitable for molding comprising a polymer blend of crosslinked organic polymer having crosslinkable functional groups and a thermoplastic resin. Among crosslinked organic polymer, polyisobutene is expressly disclosed in [0021] illustrative examples 2,3, for example. The organic polymer is further disclosed as having hydroxyl functional groups at both ends of the polymer, which are crosslinked, preferably, with isocyanate functional group containing crosslinking agent. [0041]. The thermoplastic polymer is disclosed as having either acrylic or aromatic units ([0046], illustrative examples). Among suitable crosslinking agents, diisocyanates corresponding to those claimed in claim 17 are expressly disclosed in [0041]. Intended use of the composition for roofing or building materials is inherently met by the disclosure of the reference as disclosing substantially identical compositions to those disclosed and claimed in the instant specification.

The invention as claimed, therefore, is fully anticipated by the disclosure of the Kanegafuchi '314 reference.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Kanegafuchi '341 or Kanegafuchi '607 in combination with US Patent 4,939,184 to Kennedy, (hereinafter "Kennedy '184")(of record).

The disclosure of Kanegafuchi '341 and Kanegafuchi '607 is discussed above. Both primary references expressly disclose that any isocyanate crosslinking agents are suitable for the invention, but do not exemplify isocyanates with more than 2 functional groups per molecule. However, use of isocyanates with functionality higher than 2 is notoriously known in the art for crosslinking of compounds with functional hydroxyl groups, and are used in place or together with diisocyanates when higher crosslinking/branching is desired. See, for example, Kennedy, disclosing functional equivalence of di- and tri-isocyanates for crosslinking hydroxyl-terminated polyisobutylenes.

The invention as claimed, therefore, would have been clearly obvious from the disclosure of the cited references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Irina S. Zemel
Primary Examiner
Art Unit 1796

ISZ